

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:)	
)	
Winslade, <i>et al.</i>)	
)	
Serial No. 09/687,499)	Electronically Filed on
)	
Filed: October 13, 2000)	August 15, 2011
)	
For: SYSTEM FOR ONLINE SALES)	
WITH AUTOMATIC REBATE AND)	
COUPON REDEMPTION)	
)	
Examiner: Retta, Yehdega)	
)	
Group Art Unit: 3622)	
)	
Confirmation No. 1146)	
)	

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 34-39 of the present application. A Pre-Appeal Brief and Notice of Appeal were filed April 27, 2011, and the Notice of Panel Decision was mailed June 14, 2011. Accordingly, a fee for one-month extension of time is submitted herewith.

Application Serial No. 09/687,499
Appeal Brief
August 15, 2011

REAL PARTY IN INTEREST
(37 C.F.R. § 41.37(c)(1)(ii))

The real party in interest are Christopher C. Winslade and James D. Bennett, individuals.

RELATED APPEALS AND INTERFERENCES
(37 C.F.R. § 41.37(c)(1)(iii))

Not applicable.

STATUS OF THE CLAIMS
(37 C.F.R. § 41.37(c)(1)(iii))

The present application includes claims 34-39, all of which remain rejected.¹ The Appellants identify claims 34-39 as the claims that are being appealed. The text of the pending claims is provided in the Claims Appendix.

STATUS OF AMENDMENTS
(37 C.F.R. § 41.37(c)(1)(iv))

Subsequent to the final rejection of claims 34-39 mailed January 27, 2011, the Appellants filed a Notice of Appeal and Pre Appeal Brief Request for Review on April 27, 2011. The Appellants did not amend any of the claims after the final Office Action was mailed.

¹ See January 27, 2011 Final Office Action ("Office Action") and June 14, 2011 Notice of Panel Decision from Pre-Appeal Brief Review.

SUMMARY OF CLAIMED SUBJECT MATTER
(37 C.F.R. § 41.37(c)(1)(v))

Independent claim 34 recites the following:

A method² of processing a promotion from a first party, the first party having a first system, the method comprising:

offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system;³

providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount;⁴

receiving, by the second system an online purchase request from the customer for the item for sale;⁵

² See present application at, e.g., page 36, lines 3-4; page 39, lines 3-4; page 40, lines 4-6 and 17-19; Figures 6-9.

³ See *id.* at, e.g., page 15, lines 11-18, page 36, lines 4-6; page 39, lines 5-8; page 40, lines 6-8 and 19-20; Fig. 6, ref. 609 and 613; Fig. 7, ref. 709 and 713; Fig. 8, ref. 809 and 813; Fig. 9; ref. 909 and 913.

⁴ See *id.* at e.g. page 15, lines 11-18.

⁵ See *id.* at, e.g., page 36, lines 6-7; page 39, line 8; page 40, lines 8-9 and 21-22; Fig.

responding, by the second system, to the online purchase request by collecting from the customer a purchase amount corresponding to the sales price amount less the promotion amount;⁶ and

electronically communicating, by the second system to the first system, an indication regarding the collection from the customer of the purchase amount.⁷

Independent claim 35 recites the following:

A method⁸ of processing a promotion from a first party, the first party having a first system, the method comprising:

offering, by a second system of a second party, an item for sale online at a sales price amount, the item for sale having associated with it, by the second system of the second party, a promotion from the first party, the promotion having a promotion amount, wherein the second system is distinct from the first system and the second party is distinct from the first party;⁹

receiving, by the second system, an online purchase request from a buyer for the item for sale;¹⁰

6, ref. 617; Fig. 7, ref. 717; Fig. 8, ref. 817; Fig. 9, ref. 917.

⁶ See *id.* at, e.g., page 36, lines 7-8; page 39, lines 9-10; page 40, lines 9-10; Fig. 6, ref. 621; Fig. 7, ref. 721; Fig. 8, ref. 821.

⁷ See *id.* at, e.g., page 40, line 23 – page 41, line 1; Fig. 9, ref. 925.

⁸ See present application at, e.g., page 36, lines 3-4; page 39, lines 3-4; page 40, lines 4-6 and 17-19; Figures 6-9.

⁹ See *id.* at, e.g., page 36, lines 4-6; page 39, lines 5-8; page 40, lines 6-8 and 19-20; Fig. 6, ref. 609 and 613; Fig. 7, ref. 709 and 713; Fig. 8, ref. 809 and 813; Fig. 9, ref. 909 and 913.

¹⁰ See *id.* at, e.g., page 36, lines 6-7; page 39, line 8; page 40, lines 8-9 and 21-22; Fig. 6, ref. 617; Fig. 7, ref. 717; Fig. 8, ref. 817; Fig. 9, ref. 917.

responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount;¹¹ and

causing, by the second system, shipment by the second party of the item for sale to the buyer.¹²

Independent claim 36 recites the following:

A method¹³ of processing a promotion for a first party, the first party having a first system, the method comprising:

offering, by a second system of a second party, an item for sale online, wherein the item has been acquired by the second party from the first party, the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount, wherein the second system is distinct from the first system and the second party is distinct from the first party;¹⁴

receiving, by the second system, an online purchase request from a buyer for the item for sale;¹⁵

responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales price amount less the

¹¹ See *id.* at, e.g., page 36, lines 7-8; page 39, lines 9-10; page 40, lines 9-10; Fig. 6, ref. 621; Fig. 7, ref. 721; Fig. 8, ref. 821.

¹² See *id.* at, e.g., page 14, lines 8-17; page 16, lines 15-18.

¹³ See present application at, e.g., page 36, lines 3-4; page 39, lines 3-4; page 40, lines 4-6 and 17-19; Figures 6-9.

¹⁴ See *id.* at, e.g., page 14, lines 10-12; page 36, lines 4-6; page 39, lines 5-8; page 40, lines 6-8 and 19-20; Fig. 6, ref. 609 and 613; Fig. 7, ref. 709 and 713; Fig. 8, ref. 809 and 813; Fig. 9, ref. 909 and 913.

¹⁵ See *id.* at, e.g., page 36, lines 6-7; page 39, line 8; page 40, lines 8-9 and 21-22; Fig. 6, ref. 617; Fig. 7, ref. 717; Fig. 8, ref. 817; Fig. 9, ref. 917.

promotion amount;¹⁶ and

collecting, by the second system, a service fee associated with the online purchase request.¹⁷

GROUND OF REJECTION TO BE REVIEWED ON APPEAL
(37 C.F.R. § 41.37(c)(1)(vi))

- Claims 34 and 35 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over United States Patent No. 6,915,271 to Meyer *et al.* (hereinafter “Meyer”).
- Claims 36-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of United States Application Publication No. 2002/0052778 to Murphy *et al.* (hereinafter “Murphy”).
- Claims 36 and 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of United States Patent No. 5,729,693 to Holda-Fleck (hereinafter “Holda-Fleck”).

ARGUMENT
(37 C.F.R. § 41.37(c)(1)(vii))

The Examiner has maintained the rejections of claims 34-39. As shown above, Meyer forms the basis, or a part of the basis, for all the claim rejections. Claims 34 and

¹⁶ See *id.* at, e.g., page 36, lines 7-8; page 39, lines 9-10; page 40, lines 9-10; Fig. 6, ref. 621; Fig. 7, ref. 721; Fig. 8, ref. 821.

¹⁷ See *id.* at, e.g., page 14, lines 18-19; page 34, lines 8-12; page 36, lines 7-11.

35 stand rejected as purportedly anticipated, and the remaining claims stand rejected as being purportedly obvious.

Claim 34 should be in condition for allowance at least because the cited references do not disclose "offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system" and "providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount" as recited by Claim 34.

Claim 35 should be in condition for allowance at least because the cited references do not disclose "offering, by a second system of a second party, an item for sale online at a sales price amount, the item for sale having associated with it, by the second system of the second party, a promotion from the first party, the promotion having a promotion amount, wherein the second system is distinct from the first system and the second party is distinct from the first party" or "causing, by the second system, shipment by the second party of the item for sale to the buyer" as recited by Claim 35.

Claims 36-39 should be in condition for allowance at least because the cited references do not teach, suggest, or otherwise render obvious "offering, by a second system of a second party, an item for sale online, wherein the item has been acquired

by the second party from the first party, the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount, wherein the second system is distinct from the first system and the second party is distinct from the first party” and “collecting, by the second system, a service fee associated with the online purchase request” as recited by Claim 36.

I. Meyer Does Not Anticipate Claim 34 or Claim 35

Appellants begin by addressing the anticipation rejections of claims 34 and 35. First, Appellants note some pertinent requirements to properly support a finding of anticipation. For example, a single prior art reference must disclose each and every element as set forth in the claim, either expressly or inherently described. (See MPEP § 2131.) “The **identical** invention must be shown in **as complete detail** as is contained in ... the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Additionally, the elements of the claim must be arranged as required by the claim. The Appellants respectfully submit that Meyer does not disclose each and every element of the presently claimed subject matter in the required detail or arranged as required, and does not anticipate the presently claimed subject matter.

Appellants respectfully submit that such a showing has not been made with respect to claims 34 and 35, that those claims are not anticipated by Meyer, and that those claims are allowable.

Meyer Does Not Anticipate Claim 34

For example, Claim 34 recites a method of processing a promotion from a first party, the first party having a first system, the method comprising, *inter alia*, “offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system,” and “providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion **after the customer has identified the item for sale on the second system....**” Thus, it is the second system that offers the item for sale and provides a portal wherein the customer can search for a promotion from the first party, **after** the customer has identified the item for sale on the second system. Put another way, a promotion is offered by a first party having a first system, the second system offers an item for sale online that can be identified on the second system by a customer, and the second system provides a portal containing a plurality of promotions wherein the customer can search for the promotion after the customer has identified the item for sale on the second system.

In contrast, the Office Action relies upon a purported teaching by Meyer of “offering by a second system of a second party (the service provider that runs the incentive system) items for sale at a sales price amount (items that are sold at the

websites)...” (See Office Action at p. 2.) The Office Action states that it is not relying on “Target Holt EB, Amazon.com” as the second system, but instead, “...the second system which provides items for sale is now the service provider, which provides the incentive system (where the merchants (first entity distinct from the incentive system) are included.” (See *id.* at p. 6.) Thus, the Office Action relies upon a service provider running an incentive system as teaching the second system of the second party. Therefore, to teach the same limitations as arranged by claim 34, Meyer must teach the provision of a portal by this same “second system” (i.e. the service provider providing the incentive), wherein a customer can search for the promotion after the customer has identified the item for sale on the second system. The relied upon “service provider” of Meyer does not, however, teach such “providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system....” Instead, Meyer teaches a Buy Now feature where any purported “promotion” is known before an item for sale is identified.

For example, the Office Action relies upon “fig. 19-34, col. 45 lines 19-44” as purportedly teaching “wherein the customer can search for the promotion after the customer has identified the item for sale on the second system.” (See *id.* at p. 2.) However, these figures (see, e.g. Fig. 30, 33) relate to the “Buy Now” feature, which directs the customer to a website for purchase *after* the incentive is already known.

Such a feature cannot teach anything with respect to a search for a promotion after an item for sale is identified, because in Meyer any such “incentive” is already known. The Office Action offers no explanation for how or why Meyer teaches such a search for an incentive (or why a portal for such a search would be provided) after identifying an item for purchase, when it was the incentive itself from which the consumer was originally directed to the item for purchase in the first place.

For completeness, the Appellants note that the cited portion (45:19-44) reads as follows:

The invention described herein includes user interface features that offer advantages over previously known approaches to distributing and redeeming incentives. First is the pop-up window aspect of the incentive. When a user wishes to view an incentive, the incentive pops up in a small window allowing the user to stay in the context – e.g., the Web page describing the product or the purchase location page. A second aspect is the ability not only to view, but also to clip the incentive without leaving that location. This clipping may include the user clicking on a button or otherwise indicating to the system to clip the incentive. If sign-up for membership is required during the clipping, this, too, occurs without the user needing to leave the context by a separate window popping up.

When viewing incentives in a pop-up window, yet another aspect of the user interface is the means for the user to go to the purchase site for the goods or services for which the incentive applies. This means may be the Buy Now button or an icon or a hyperlink. The purchase site may be a different site than the one where the incentive was first viewed by the member. This offers a convenient way to purchase goods or services associated with an incentive. In another aspect, the member can complete the purchase by filling in a pop-up online form, still without necessarily leaving the context where the incentive icon was first viewed.

Again, such a teaching does not teach providing a portal as fully set forth by Claim 34. For example, such a pop-up window only includes one incentive that is already known, and thus cannot teach "...a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale...." Further still, the Office Action does not identify any "identification on the second system" by a customer, other than the "Buy Now" feature. However, the Buy Now feature of Meyer is only employed, by definition, after the incentive is already known, as the Buy Now button is displayed as part of the incentive view. Thus, Meyer does not teach anything with respect to searching for a promotion after the identification on the second system, let alone "providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system..." as fully set forth by Claim 34.

Further explaining its rejection of Claim 34, the Office Action asserts that "[t]he claim does not recite that the portal is provided after the item is selected or selected for sale. The claim recites wherein the customer can search for the promotion after the customer has identified the item for sale." (See Office Action at p. 7.) This justification fails for at least two reasons. First, the "wherein the customer can search..." clause describes the providing of the portal, so that such a portal must be provided after the identification of the item for sale so that the customer can search after identifying the

item for sale. (Also, the claim requires such an identification to be on the second system.) The claim plainly recites **“providing by the second system a portal...wherein the customer can search for the promotion after the customer has identified the item for sale.”** It follows that for the customer to search the portal after the customer has identified the item for sale, the portal is provided after the item has been identified for sale.

Second, even if the claim is somehow construed to allow the portal to be provided before the item is “selected or selected for sale” as asserted by the Office Action, Meyer still does not teach anything with respect to searching for a promotion after the customer has identified an item for sale. The relied upon “Buy Now” feature of Meyer is a part of the incentive display itself. Because Meyer is utterly silent with respect to searching for a promotion after identification of an item for sale, Meyer does not teach providing of a portal by the second system as arranged as required by Claim 34. Indeed, because Meyer teaches linking to a sales location after display of the incentive itself, Meyer teaches the opposite of and teaches away from the presently claimed subject matter.

Yet further still, Claim 34 recites **“offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system”** and **“wherein the customer can search for the promotion after the customer has identified**

the item for sale on the second system.” Thus, the identification on the second system must be of an item offered on the second system at “a sales price amount.” In contrast, the Buy Now feature of Meyer does not offer the item “at a sales price amount” at the time of any purported identification on the second system by clicking on the Buy Now button. Instead, when the Buy Now button is clicked, incentives are being displayed in Meyer, not an item being offered at a sales prices amount. (See, e.g., Meyer at Fig. 33 (“\$5 off Windsor Mugs...Free Beanie Baby with Toy Purchase...20% off Wool Blazer....”)) Meyer thus fails to teach the identification of an item at a sales price amount on the second system, let alone any portal where a customer can search for a promotion after such an identification as fully set forth by Claim 34. Thus, because the Buy Now feature fails to teach identification of an item offered at a sales price amount on the second system, Meyer further fails to anticipate Claim 34.

Thus, the Appellants respectfully submit that Meyer does not anticipate Claim 34, and that Claim 34 is allowable.

Meyer Does Not Anticipate Claim 35

The Appellants next address the rejection of Claim 35 as purportedly anticipated by Meyer. Claim 35 recites, a method of processing a promotion from a first party, the first party having a first system, the method comprising, *inter alia*, “offering, by a second system of a second party, an item for sale online at a sales price amount” and

“responding, by the second system, to the online purchase request by collecting from the buyer...” where the item for sale has associated with it by the second system of the second party “a promotion from the first party.” The promotion from the first party has “a promotion amount.” Claim 35 further recites that “the second system is distinct from the first system and the second party is distinct from the first party.” Claim 35 also recites “causing, by the second system, **shipment by the second party....**” Therefore, Claim 35 expressly requires that the promotion is from a first party, and that a distinct second party, *inter alia*, offers the item for sale online, and ships the item.

The cited portions of Meyer, however, do not teach such a second system (as fully defined throughout the claim) causing shipment by a second party. For example, the Office Action cites to Meyer at 41:22-40 as teaching “causing, by the second system, shipment by the second party...”, yet this portion of Meyer merely teaches the “service provider” (the alleged second party/system) providing information to a vendor so that the vendor may ship. That portion reads as follows:

In an alternate embodiment of the buy now procedure, the purchase screen is a pop-up that asks the member for all information necessary to complete the purchase (which may include the member’s credit card number, address for shipping, and so on). When the member supplies the necessary information and clicks a “Confirm Buy Now” button, the service provider validates the credit card, and then sends the purchase order (including credit card number) electronically using a secure protocol to the vendor of the merchandise for processing. In an [sic] yet another alternate embodiment, the service provider actually charges the purchase to the member’s credit card, and then informs the vendor of the transaction, giving the vendor all information necessary for the vendor to fulfill the purchase (i.e., to

send the product to the member). The member then is provided with the necessary information to collect the goods or with a confirmation that delivery will take place. Since an actual incentive redemption took place, the redemption recording activities described below also need to take place take place. [sic]

As can be seen above, in Meyer the purported “second party” does not ship. Instead, information is provided to the vendor, and the vendor ships. The Office Action asserts that “[t]he claim recites causing by the second system shipment of the item but **does not positively recite the second party shipping the item** (i.e., the item is directly shipped by the second system of the second party).” (See Office Action at p. 7; emphasis added.) This is directly contrary to the plain language of the claim: “causing, by the second system, **shipment by the second party** of the item for sale to the buyer.” Claim 35 plainly recites that the second system causes “shipment by the second party.” The Office Action’s assertion that “the claim does not positively recite the second party shipping the item” is thus incorrect. Claim 35 requires shipment by the second party. Meyer does not teach its purported second party shipping. Meyer does not teach the limitations of Claim 35 in the required detail, nor the limitations of Claim 35 arranged as required by that claim.

Thus, for at least the reasons discussed above, the Appellants respectfully submit that Meyer does not anticipate Claim 35, and that Claim 35 is allowable.

II. The Proposed Combination Of Meyer and Holda-Fleck Does Not Render Claims 36-39 Unpatentable

The Appellants now turn to the rejection of claims 36-39 as being unpatentable over Meyer in view of other references.

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.

* * *

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. **If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.**

See M.P.E.P. at § 2142 (emphasis added).

Appellants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness for independent Claim 36 and Claims 37-39 that depend from Claim 36, and that those claims are allowable.

Meyer and Murphy Do Not Render Claims 36-39 Obvious

Independent Claim 36 recites a method of processing a promotion for a first party, the first party having a first system, the method comprising, *inter alia*, offering, by a second system of a second party, an item for sale online, **wherein the item has been acquired by the second party from the first party...** Further, the item for sale has “associated with it a promotion from the first party, the promotion having a

Application Serial No. 09/687,499
Appeal Brief
August 15, 2011

promotion amount,” and “the second system is distinct from the first system and the second party is distinct from the first party.” Also, Claim 36 recites “collecting, by the second system, a service fee associated with the online purchase request.” The Appellants respectfully submit that the cited references, either alone or in combination, do not teach, suggest, or otherwise render obvious at least these aspects of claim 36.

For example, the cited art fails to render obvious “...wherein the item has been acquired by the second party from the first party...” The Office Action relies on Meyer as purportedly teaching this aspect of Claim 36. (See Office Action at p. 4: “(customer purchasing the items at the second party (promotional site)(see col. 40 line 67 to col. 41 line 2”).) The Office Action further asserts that “it is unclear if applicant mean[s] for the second party to physically obtain the item from the first party or to just have.” (See *id.* at p. 7.) As an initial matter, regardless of whether the second party must “physically obtain the item” or “just ha[s]” the item, Meyer fails to disclose such a second party. The purported “second party” of Meyer merely relates to a web site with the “Buy Now” feature, and is utterly silent with respect to the purported second party either physically obtaining or “just having” the item for sale.

In any event, the Appellants respectfully submit the claim plainly states that “the item has been acquired by the second party from the first party,” which is different than “to just have.” Further, the Office Action also attempts to switch which aspects of Meyer disclose the various parties of Claim 36, and later asserts the merchants in Meyer as the second party (instead of the previously relied upon “promotional site”) and also

switches to manufacturers as the purported first party. (See *id.* at p. 7-8.) However, the Appellants are unable to find any example, teaching, or suggestion in Meyer of a promotion from a manufacturer of goods, with a separate and distinct vendor acquiring the goods from the manufacturer, and the vendor offering the goods for sale online, let alone the subject matter of claim 36 as fully set forth. The mere acquisition by vendors of products from manufacturers cannot be stretched so far as to teach, suggest, or otherwise render obvious a promotion from a first party having a first system, and a distinct second system of a distinct second party offering an item for sale online that has been acquired by the second party from the first party, with the item for sale having associated with it a promotion from the first party.

The Office Action acknowledges that “Meyer does not teach collecting, by the second system, a service fee from the buyer,” but instead relies upon Murphy as teaching this aspect of Claim 36. (See Office Action at p. 4.) Without conceding that Murphy qualifies as prior art, the Appellants respectfully submit that Murphy fails to remedy the acknowledged shortcomings of Meyer. For example, the purported “service fee” of Murphy is not collected by a second system (that offers the item for sale online) as required by Claim 36. Instead, in Murphy, the “\$50 fee” is collected by a website operator, but the incentive is used when buying a product neither purchased from the website operator, nor even purchased online, as Murphy discusses an automobile purchase at a dealership. (See Murphy at [0018].) Further still, claims dependent from Claim 36 are allowable over the combination of Meyer and Murphy for additional

reasons. For example, Claim 38 recites “wherein a first amount is defined by the sales price less the promotion amount, and the purchase amount collected from the buyer equals the first amount plus the service fee.” In Murphy, the website operator merely collects only the “\$50 fee.” The Appellants respectfully submit such a disclosure does not teach, suggest, or otherwise render obvious “wherein a first amount is defined by the sales price less the promotion amount, and the purchase amount collected from the buyer equals the first amount plus the service fee.”

For at least the above reasons, the Appellants respectfully submit that the Office Action does not present a *prima facie* case of obviousness for Claims 36-39. The Appellants further respectfully submit that Meyer and Murphy, either alone or in combination, do not teach, suggest, or otherwise render obvious those claims, and that those claims are allowable.

Meyer and Holda-Fleck Do Not Render Claims 36 and 39 Obvious

The Office Action also asserts that the combination of Meyer and Holda-Fleck renders Claim 36 and Claim 39 obvious. The Appellants have already discussed the shortcomings of Meyer above. Further, the Appellants note that the cited portion of Holda-Fleck relates to collection of a service charge by a telephone service provider. Such a telephone service provider does not offer items for sale online or collect a purchase amount, in contrast to the subject matter of Claim 36. In the cited portion of

Application Serial No. 09/687,499
Appeal Brief
August 15, 2011

Holda-Fleck, the item has already been purchased before the telephone service is accessed. (See Holda-Fleck at 3:3-32.) This is very different from Claim 36, which recites that the second system of the second party that offers an item for sale online, also collects a purchase amount, and also collects a service fee. Thus, the service charge in Holda-Fleck is not collected by the “second party” as set forth in the Claim 36. Yet further still, the service fee in Claim 36 is “associated with an online purchase request.” In contrast, the service provider of the cited portion of Holda-Fleck is not even accessed until after an item is purchased. Such a disclosure cannot teach, suggest, or otherwise render obvious collecting a service fee associated with an online purchase request.

For at least the above reasons, the Appellants respectfully submit that the Office Action does not present a *prima facie* case of obviousness for Claims 36 and 39. The Appellants further respectfully submit that Meyer and Holda-Fleck, either alone or in combination, do not teach, suggest, or otherwise render obvious those claims, and that those claims are allowable.

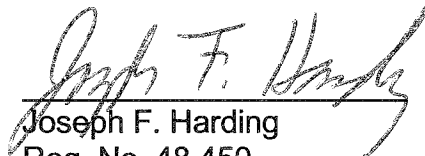
Application Serial No. 09/687,499
Appeal Brief
August 15, 2011

III. Conclusion

For at least the reasons discussed above, the Appellants respectfully submit that the pending claims are allowable in all respects. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 34-39. The Commissioner is authorized to charge any fees that may be required, or credit any overpayment to Deposit Account No. 13-0017.

Date: August 15, 2011

Respectfully submitted,


Joseph F. Harding
Reg. No. 48,450

McAndrews, Held & Malloy
500 W. Madison Street
34th Floor
Chicago, IL 60661
Telephone: 312-775-8200

CLAIMS APPENDIX
(37 C.F.R. § 41.37(c)(1)(viii))

1-33. Cancelled

34. A method of processing a promotion from a first party, the first party having a first system, the method comprising:

offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system;

providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount;

receiving, by the second system an online purchase request from the customer for the item for sale;

responding, by the second system, to the online purchase request by collecting from the customer a purchase amount corresponding to the sales price amount less the promotion amount; and

electronically communicating, by the second system to the first system, an indication regarding the collection from the customer of the purchase amount.

35. A method of processing a promotion from a first party, the first party having a first system, the method comprising:

offering, by a second system of a second party, an item for sale online at a sales price amount, the item for sale having associated with it, by the second system of the second party, a promotion from the first party, the promotion having a promotion amount, wherein the second system is distinct from the first system and the second party is distinct from the first party;

receiving, by the second system, an online purchase request from a buyer for the item for sale;

responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount; and

causing, by the second system, shipment by the second party of the item for sale to the buyer.

36. A method of processing a promotion for a first party, the first party having a first system, the method comprising:

offering, by a second system of a second party, an item for sale online, wherein

the item has been acquired by the second party from the first party, the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount, wherein the second system is distinct from the first system and the second party is distinct from the first party;

receiving, by the second system, an online purchase request from a buyer for the item for sale;

responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales price amount less the promotion amount; and

collecting, by the second system, a service fee associated with the online purchase request.

37. The method of claim 36 wherein the service fee is collected from the buyer.

38. The method of claim 37 wherein a first amount is defined by the sales price less the promotion amount, and the purchase amount collected from the buyer equals the first amount plus the service fee.

39. The method of claim 36 wherein the service fee is collected from the first party.

Application Serial No. 09/687,499
Appeal Brief
August 15, 2011

EVIDENCE APPENDIX
(37 C.F.R. § 41.37(c)(1)(ix))

- (1) United States Patent No. 6,915,271 ("Meyer"), entered into record by Examiner in November 23, 2005 Office Action.
- (2) United States Application Publication No. 20020052778 ("Murphy"), entered into record by Examiner in September 25, 2009 Office Action.
- (3) United States Patent No. 5,729,693 ("Holda-Fleck"), entered into record by Examiner in September 25, 2009 Office Action.

Application Serial No. 09/687,499
Appeal Brief
August 15, 2011

RELATED PROCEEDINGS APPENDIX

(37 C.F.R. § 41.37(c)(1)(x))

Not applicable.